THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. DICKINSON and CHRISTOPHER P. RANDELL

Appeal No. 1998-2326
Application No. 08/427,070

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, ABRAMS, and MCQUADE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON RECONSIDERATION

In a decision on appeal mailed August 20, 1998, this panel of the Board affirmed the examiner's decision finally rejecting claims 14-17 of this reissue application, and entered a new rejection of claims 14-17 under 35 U.S.C. § 251 and, alternatively, under 35 U.S.C. § 112, first paragraph, as containing new matter not supported by the original disclosure of

the patent upon which the reissue application is based (Paper No. 19). The appellants responded with what we shall consider to be a request for reconsideration (Paper No. 20) inasmuch as the appellants have therein renewed their argument that our decision affirming the examiner's rejection under 35 U.S.C. § 103 was in error, as well as presenting an amendment to the drawings with argument as to why the new rejection we entered under 35 U.S.C. § 251 and, alternatively, under the first paragraph of 35 U.S.C. § 112, should not stand. As the appellants requested, the application was remanded to the examiner for consideration of the proposed amendment before being reconsidered by the Board.

Regarding The Examiner's Rejection Under 35 U.S.C. § 103

The arguments provided by the appellants in Paper No. 20 are the same as those presented in the Briefs. We found them not to be persuasive then, and we maintain that position now, for the same reasons that were expressed in our decision (Paper No. 19).

Regarding The Board's Rejection Under 35 U.S.C. § 251 and 35 U.S.C. § 112, First Paragraph

It is our view that there is no support in the disclosure of the application which led to the patent for which reissue is being sought for certain of the structure recited in independent claims 14 and 16, and for that reason we entered a new rejection

under 37 CFR § 1.196(b) in Paper No. 19, citing four instances. The appellants responded with argument and an amendment to the drawings in an effort to overcome it. However, it is our view that these efforts are not persuasive.

Claim 14 states that there is an "opening" under the patient bed through which the lower magnetic pole can pass, and that this opening is defined by spaced-apart structures "depending" from the bed. We first point out that the original disclosure does not describe the structure in terms of spaced-apart structures at all, much less such elements "depending" from the bed, nor is the term "opening" used in this context. Even if we accede to the appellants' position that the original specification provides support for the presence of elements 32, there is no basis from which to conclude that these spaced-apart elements depend, that is, extend downwardly from,[1] the patient bed to define the opening, as is required by the claim. From our perspective, the specification of the original application and the drawings,

[1]The applicable common definition of "depend" is "to hang down." See, for example, Merriam Webster's Collegiate Dictionary, tenth Edition, 1996, page 310. No other definition for this term has been established in the specification.

original or amended,[2] at best establish only the presence of elements 32, and not that they depend downwardly from the patient bed to define an opening. As described and shown, elements 32 could just as well extend upwardly from base 25 or be unattached to either and merely interposed between the bed and the base. It therefore is our conclusion that this structure constitutes new matter in that the disclosure of the application as originally filed does not provide support for it, and therefore reasonably does not convey to the artisan that the appellants had possession of the invention recited in claim 14 at the time the application was filed, as is required by 35 U.S.C. § 251 and the first paragraph of Section 112.[3]

Independent claim 16 recites the step of placing the patient on a movable bed "having an aperture in an undercarriage disposed below the bed." The rationale set forth above applies here, also. Initially, we point out that the terms "aperture" and "undercarriage" are not used in the original disclosure to

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[2]We note that there is an inconsistency in the manner in which elements 32 are represented in Figure 4 the drawings filed with the reissue application and the amended version.

[3]See, for example, Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

describe the structure. Moreover, that disclosure does not reasonably establish what is considered to be the undercarriage, or that there is an aperture therein. In our opinion, in view of the disclosure, the aperture could just as well be defined by elements extending upwardly from the upper surface of base 25 or elements interposed between the base and the bed but not attached to either. Thus, as was the case above, the description does not reasonably convey to the artisan that the appellants had possession of the invention recited in claim 16 at the time the application for the patent from which reissue is requested was filed.[4]

SUMMARY

We hereby make final our decision affirming the examiner's rejection under 35 U.S.C. § 103 and entering our rejection under 35 U.S.C. § 251 and, alternatively, 35 U.S.C. § 112, first paragraph.

[4]We recognize that the examiner entered the amendment to the drawing, however, we are not bound by his opinion that it overcame the rejections under 37 CFR § 1.196(b).

Therefore, while we have reconsidered our decision of August 20, 1998, in the light of the arguments and amendment submitted by the appellants in Paper No. 20, we will not modify that decision, and to that extent the request for reconsideration is denied.

DENIED

HARRISON E. MCCANDLISH
Senior Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. MCQUADE
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

NEA/sld

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